



Docket No.: 1341.1163

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of:

Mitsuo WATANABE et al.

Serial No. 10/694,274

Group Art Unit: 2876

Confirmation No. 2798

Filed: October 29, 2003

Examiner: CAPUTO, LISA M.

For: BAR CODE READER AND BAR CODE READ CONTROL METHOD

**COMMUNICATION TO THE EXAMINER REQUESTING WITHDRAWAL OF THE FINAL
OFFICE ACTION OF OCTOBER 4, 2004, SINCE PREMATURE UNDER MPEP 706.07 AND
ISSUANCE OF A NEW, NON-FINAL OFFICE ACTION SETTING A NEW RESPONSE PERIOD**

Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

Sir:

Applicants respectfully submit that the Office Action mailed October 4, 2004 (current Action) is prematurely made final by the new grounds of rejection in Items 2-4 of the current Action.

Item 5 of the current Action indicates that "Applicant's arguments with respect to claims 1-8 have been considered but are moot in view of the new ground(s) of rejection." (Action at page 7).

Further, in item 7 the Examiner contends, erroneously, that "Applicant's amendment necessitated the new ground(s) of rejection presented in this Office Action. Accordingly, THIS ACTION IS MADE FINAL. See, MPEP §706.07(a)."

Applicants respectfully submit that the Examiner errs in this position, since the only amendments made to claims 1-4 were directed to an amendment for form only to the preamble of independent claim 1. Specifically, the preamble of independent claim 1 was amended for form only to recite "(a) bar code reader. . . , the bar code reader comprising. . . ." (Emphasis added indicating amendment).

As set forth in MPEP §706.07(a) entitled "Final Rejection, When Proper on Second Action" a new ground of rejection is not made properly final when "the new ground of rejection is

neither necessitated by applicant's amendment of claims" In addition, as set forth in MPEP § 706.07(d):

(i)f, on request by applicant for reconsideration, the primary examiner finds the final rejection to have been premature, he or she should withdraw the finality of the rejection.

CONCLUSION

Accordingly, withdrawal of the Finality of the Action mailed October 4, 2004 is mandated since premature, pursuant to MPEP 706.07 and the same accordingly should be withdrawn and a new, non-final Office Action issued, setting a new Response period based on the mailing date of same.

If there are any additional fees associated with filing of this Amendment, please charge the same to our Deposit Account No. 19-3935.

Respectfully submitted,

STAAS & HALSEY LLP

Date: December 6, 2004

By: Paul W. Bobowiec
Paul W. Bobowiec
Registration No. 47,431

1201 New York Avenue, NW, Suite 700
Washington, D.C. 20005
Telephone: (202) 434-1500
Facsimile: (202) 434-1501